

REMARKS**The Rejection of Claim 1**

Applicant respectfully requests that the Examiner reconsider his rejection of Claim 1 for the following reasons:

(1) **Solves Different Problems.** The present invention solves a different problem than the inventions disclosed by the references cited by the Examiner and the problem solved by the present invention is cited in the claims. 2001-46568 discloses a golf club designed to “stabilize gripping of a golf club to improve swing stability by forming a reverse taper part with the outer diameter gradually reduced toward the grip end on the grip part”(Abstract). Miyasu discloses a longitudinal rail on a golf club grip for the purpose of “...comforting player’s hands while holding the grip and facilitating shaft alignment and preventing the grip from slipping away from the player’s hands while hitting balls”(Abstract). In sum, the references cited by the Examiner disclose golf club grips that are intended to enhance comfort in either gripping the golf club (Miyasu) or swinging the golf club (2001-26568). The present invention contemplates an improved golf club grip that enhances performance (page 2, lines 12-15, 18-26; page 3, lines 18-20; page 4, lines 3-7, 9-11, 19-21; page 5, lines 3-5). The present invention also claims to solve this problem in the language of the claims by providing “...an improved grip for the

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users hand and better control of the golf club.” (Last line of Claim 1 and Claim 6).

Applicant relies upon *In re Wright*, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988), wherein the Court held that “the determination of whether a novel structure is or is not ‘obvious’ requires cognizance of the properties of that structure and the problems which it solves, viewed in light of the teaching of the prior art...” The prior art teaches enhanced comfort whereas the present invention teaches enhanced performance. Applicant believes this distinction should be sufficient to overcome the Examiner’s rejection.

(2) **Inoperative References.** Both references cited by the Examiner are inoperative in that they do not conform to the United States Golf Association Rules of Golf (2004-2005) and as such, they should not be considered disqualifying. Appendix II, 3(ii) to the United States Golf Association Rules of Golf (2004-2005) states that “...For clubs other than putters, the grip **must be** circular in cross-section...” (Emphasis added). However, as the examiner correctly pointed out, neither 2001-46568 nor Miyasu disclose a grip having an external surface of substantially circular cross-section throughout the length of a body. The present invention was designed to specifically comply with all specifications and requirements articulated in the United States Golf Association Rules of Golf

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(2004-2005). Applicant has confirmed that the present invention does in deed comply with the United States Golf Association Rules of Golf (2004-2005) and has attached (as Attachment A) a copy of a letter from the United States Golf Association to substantiate Applicant's position. Applicant maintains that the present invention could not rely upon non-conforming, inoperative prior art and still comply with the United States Golf Association Rules of Golf (2004-2005). Applicant believes that the fact that the present invention complies with the United States Golf Association Rules of Golf (2004-2005) while the references cited by the Examiner do not is a sufficient-enough distinction between the present invention and the prior art to overcome the Examiner's rejection of Claim 1.

(3) **Weak Foreign Reference.** The Examiner has referred to a Japanese Patent, 2001-46568, in combination with a U.S. Patent, Miyasu. While Applicant appreciates the scope of 35 U.S.C. 103 (a), Applicant also believes that Japanese Patent 2001-46568 should be narrowly construed to preclude translations, vagueness, or syntax errors from inadvertently disqualifying otherwise patentable subject matter. 2001-46568 discloses a golf club grip that does not conform to the United States Golf Association Rules of Golf (2004-2005); the present invention does so conform. 2001-46568 discloses a golf club grip that was designed to

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enhance comfort; the present invention was designed to enhance performance.

Applicant believes that relevance of 2001-46568 to the present invention should be viewed in light of those distinctions and that those distinctions should be sufficient to overcome the Examiner's rejection of Claim 1.

(4) **Crowded Field.** The present invention is classified in a crowded art and any improvement, regardless of how small, should be considered as a significant step forward. Further, improvements or steps forward in this crowded art field are made more difficult by the need to comply with the United States Golf Association Rules of Golf (2004-2005). While novel inventions and novel improvements to the prior art in this crowded art field may well be patentable, very few will meet the stringent requirements articulated in the United States Golf Association Rules of Golf (2004-2005)(such as those disclosed by 2001-46568 and Miyasu). Applicant believes that the present invention's improvements in a crowded field that is substantially narrowed by the need to comply with the United States Golf Association Rules of Golf (2004-2005) should be sufficient to overcome the Examiner's rejection of Claim 1.

(5) **No Suggestion Flowing From The Prior Art.** Applicant maintains that the prior art cited by the Examiner does not suggest any combination of the

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references. The Court in *Pro-Mold and Tool Co., Inc. v. Great Lakes Plastics, Inc.* 75 F.3d 1568, 37 USPQ2d 1626 (Fed. Cir. 1996) observed that (1) “It is well-established that before a conclusion of obviousness may be made based upon a combination of references, there must have been a reason, suggestion, or motivation to lead an inventor to combine those references. Further, the court in *Velander v. Garner*, 348 F3d 1359, 68 USPQ2d 1769 (Fed. Cir. 2003) held that “If all the elements of an invention are found in a combination of prior art elements, a proper analysis under § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill in the art would have a reasonable expectation of success.” The *Velander* court goes on to state that “Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant’ disclosure.”

These decisions would suggest that the prior art cited by the Examiner must articulate the combination of elements as disclosed by the present invention. Applicant does not believe that the prior art cited by the Examiner meets this

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standard. Further, given that the prior art teaches a reverse-taper grip to address swing stability (2001-46568) and an elevated ridge to prevent the club from slipping out of one's hands (Miyasu) and the present invention teaches a reverse taper to improve control and an elevated ridge to promote consistent placement in one's hands, the nexus between the cited prior art and the present art is not apparent. Applicant maintains that the prior art provides no reason, motivation, or suggestion to combine the prior art references cited by the Examiner and believes that the absence of such reason, motivation, or suggestion should be sufficient to overcome the Examiner's rejection of Claim 1.

(6) **Long Felt Need.** The present invention solves a long-existing, long-felt, but unresolved need in the game of golf: correcting what is known in the game as a "slice." Typically, the "slice" problem which has plagued mid-to-high handicap golfers for decades, has been attributed to the practice of holding the golf club in the palms (as opposed to the fingers as is the case with the present invention). Traditional golf club grips make it too easy for a recreational golfer to grip the club in the palm of their hands. The design of the grip disclosed by the present invention permits the user to hold the golf club in just the fingers of the hand (as opposed to the palms) to create a quicker and more powerful release through impact and

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thereby producing greater distance with improved accuracy. This type of design also reduces tension, which robs speed and distance, while promoting good pronation through the impact area.

Applicant's in-house testing has shown that the grip disclosed in the present invention has eliminated the "slice" from 38.7 % of the golfers it tested and reduced the "slice" enough to substantially improve the game of an even larger percentage of the golfers tested. Further, in recognition of the improvement to the game offered by the present invention, Golfweek Magazine awarded the golf club grip disclosed by the present invention honors as the "Top Discovery of the 2004 PGA Merchandise Show." Further still, Applicant has hosted several "challenges" in which randomly selected participants were selected from groups of beginners, mid-handicappers, and PGA Tour player and asked to hit six golf balls with their clubs having a "traditional" grip and then to hit six golf balls with clubs having the grip disclosed by the present invention. Remarkably, every single one of the participants saw a marked improvement in the distance of their driver and irons shots. More significantly, accuracy increased by over 49% on the average and some participants, namely the beginners and the high (16+) handicappers, experienced a significant increase in accuracy and distance while virtually

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eliminating their slices.

In view of the foregoing empirical data, Applicant feels that the present invention has solved a long-felt and long-standing problem in the field of recreational golf. Applicant also believes that the solution to this problem has evaded the attempts of previous inventors. As such, Applicant feels that this solution is sufficient to overcome the Examiner's rejection of Claim 1.

(7) **Professional Recognition.** As Applicant has pointed out in paragraph (6), the present invention has been recognized professionally. The present invention has been given an award and recognized in a professional publication for its improvement to the game: Golfweek Magazine (February 7, 2004) awarded the golf club grip disclosed by the present invention honors as the "Top Discovery of the 2004 PGA Merchandise Show." Additionally, the golf grip disclosed by the present invention has recognized as "revolutionary" or a "breakthrough" in numerous other professional publications including, without limitation: (1) March 3, 2004: Article in "The Wire" a golf-related transactional newsletter (www.golftransactions.com/wirereleases/2004); (2) March 18, 2004: Article in "The Wire" (3) March 29, 2004: Article in "The Wire" (4) April, 2004: Article in "Golf Illustrated," a nationally distributed golf magazine stated that

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[Applicant's] innovation, along with hybridization...are all part of the present and future of golf. Each represents a substantial innovation..." (5) April 22, 2004: Article in "The Wire" (6) May 5, 2004: Article in "The Wire"(7) June 1, 2004: Article in "The Wire" (8) May/June , 2004: Article in "Pub Links" a nationally distributed golfing magazine stated that "[Applicant] has designed a revolutionary new golf grip that is USGA approved and unlike anything you've ever seen before... It's a major break-through in golf equipment technology..." (9) May/June 2004: In the "New On The Tee" section of "Pub Links"Golf Magazine, the present invention was described as "...a Game Improvement piece of golf equipment as defined by the USGA and is USGA approved." It went on to add that "[t]his grip is a major breakthrough in golf equipment technology..." (10) July/August, 2004: Front Cover insert on "Partners" the official magazine of the Professional Golfers' Association stated as its bottom line on the present invention: "Why didn't someone think of this a long time ago?" (11) July 6, 2004 Article in "The Wire"(12) August, 2004: Insert in "Executive Golfer" a nationally distributed golfing magazine stated that the present invention "promises to be a major breakthrough in golf equipment technology." These comments are indicative of the recognition by industry professionals, who are certainly knowledgeable of any and all developments in the

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game of golf, of the present invention's innovative features and its contribution to the game of golf. Applicant believes that this professional recognition would not be given to an invention that was "copied" or "borrowed" from the prior art. As such, Applicant believes that this substantial amount of professional recognition of the present invention should be sufficient to overcome the Examiner's rejection of Claim 1.

The Rejections of Claim 2

In response to the Examiner's comments in paragraphs 2 and 3, Applicant has amended the shaft dimensions in Claim 2 (currently amended) to be consistent with the language of Claim 1 upon which Claim 2 (currently amended) depends. Accordingly, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 2 which was based upon 35 U.S.C. §112.

In response to the Examiner's comments in paragraphs 4 and 6, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 2 for the same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claim 1.

Further, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 2 for the following additional reason:

REMARKS (continued)

Multiplicity of References. Applicant believes the fact that a large number of references (in this case, three) must be combined to meet the present invention is evidence of unobviousness. Further, Applicant believes that combination suggested by the Examiner requires a series of separate, awkward combinative steps that are too involved to be considered obvious. When considered in light of the fact that the present invention solves a different problem than those addressed by the cited references, Applicant believes the suggested combination to be all the more unobvious and therefore sufficient to overcome Examiner's rejection of Claim 2.

The Rejection of Claim 3

In response to the Examiner's comments in paragraphs 4 and 6, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 3 for the same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claim 1.

Further, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 3 for the following additional reason:

Multiplicity of References. Applicant believes the fact that a large number of references (in this case, three) must be combined to meet the present invention is evidence of unobviousness. Further, Applicant believes that combination suggested

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by the Examiner requires a series of separate, awkward combinative steps that are too involved to be considered obvious. When considered in light of the fact that the present invention solves a different problem than those addressed by the cited references, Applicant believes the suggested combination to be all the more unobvious and therefore sufficient to overcome Examiner's rejection of Claim 3.

The Rejection of Claim 4

In response to the Examiner's comments in paragraphs 4 and 5, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 4 for the same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claim 1.

The Rejection of Claim 5

In response to the Examiner's comments in paragraphs 4 and 5, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 5 for the same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claim 1.

The Rejection of Claim 6

In response to the Examiner's comments in paragraphs 4 and 5, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 6 for the

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same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claim 1.

The Rejections of Claim 7

In response to the Examiner's comments in paragraphs 2 and 3, Applicant has amended the shaft dimensions in Claim 7 (currently amended) to be consistent with the language of Claim 6 upon which Claim 7 (currently amended) depends. Accordingly, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 7 which was based upon 35 U.S.C. §112.

In response to the Examiner's comments in paragraphs 4 and 6, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 7 for the same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claim 1.

Further, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 7 for the following additional reason:

Multiplicity of References. Applicant believes the fact that a large number of references (in this case, three) must be combined to meet the present invention is evidence of unobviousness. Further, Applicant believes that combination suggested by the Examiner requires a series of separate, awkward combinative steps that are

REMARKS (continued)

too involved to be considered obvious. When considered in light of the fact that the present invention solves a different problem than those addressed by the cited references, Applicant believes the suggested combination to be all the more unobvious and therefore sufficient to overcome Examiner's rejection of Claim 7.

The Rejection of Claim 8

In response to the Examiner's comments in paragraphs 4 and 5, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 8 for the same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claim 1.

New Claims 9 through 16

Applicant has submitted (new) Claims 9 through 16 which disclose a flared cap end that is simply another version of the cap end 24 disclosed in Application Nr. 10/783,011 (page 7, lines 3, 8, 10, 12, 16, 19; page 8, lines 7, 13; page 9, lines 2, 10; Claim 1, line 3). Although Applicant believes that the comments provided in the preceding paragraphs distinguish the present invention from the prior art cited by the Examiner sufficiently to overcome the Examiner's rejections of Claims 1-8, Applicant believes that disclosing this embodiment will further distinguish the present invention from the prior art cited by the Examiner.

Prior Art of Record

In response to the Examiner's comments in paragraph 7, Applicant has reviewed the prior art references cited by the Examiner and believes that these references are not disqualifying.

CONCLUSION

For all the above reasons, Applicant submits that the claims are now in proper form, and that the claims all define subject matter that is patentable over the prior art.

Therefore, Applicant submits that this application is now in condition for allowance, which action Applicant respectfully requests.

CONDITIONAL REQUEST FOR CONSTRUCTIVE ASSISTANCE

Applicant has amended the claims of this application so that they are proper, definite, and define novel structure which is also non-obvious. If for any reason this application is not believed to be in full condition for allowance, Applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P § 2173.02 and § 707.07 (j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Very respectfully,

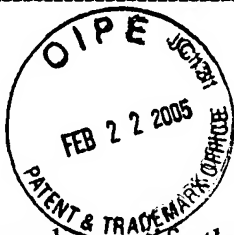


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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence and attachments will be deposited with the United States Postal Service by First Class Mail, postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, Post Office Box 1650, Alexandria, VA 22313-1450 on the date below.

Date February 16, 2005

Inventor's Signature

A handwritten signature in cursive script, appearing to read "R. Lee", written over a horizontal line.